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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,465

12/02/2003

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22931 7590 10/07/2008

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EXAMINER

SWINEHART, EDWIN L

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/726,465
Filing Date: December 02, 2003
Appellant(s): MCDUGLE ET AL.

Michael F. Hughes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/28/2008 appealing from the Office action mailed 3/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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3,082,732

Stallman

3-1963

Appellant's admission of sales more than one year before filing, as set forth in Declaration filed 9/13/2004.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 30-38 stand rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's disclosed Offer for Sale of the claimed invention.

Applicant's disclosed device offered for sale more than one year before filing shows the invention as claimed. The central thruster section with a pair of extensions for preventing ambient air from entering the thruster are clearly shown in the detailed drawings provided, and discussed in the accompanying Declaration. The claimed dimensions are clearly shown in the provided evidence.

Claims 1-29 and 39-48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view of Den Ouden.

Applicant's disclosed for sale device was mounted below the bottom edge of the transom, and therefore would not be clear of the water during high speed maneuvering, and therefore would present a high degree of drag, as would be known to the ordinary routineer working in the art, therefore, the mounting of the device above the waterline during high speed planing was not disclosed.

Den Ouden teaches the positioning of such a thruster so that it is clear of the water when the boat is operated at high speed.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to raise the position of the thruster offered for sale more than one year before filing by Applicant to a position as taught by Den Ouden, such that it would clear the water when the boat is at high speeds.

Such a combination would have been desirable at the time of the invention so as to provide for reduced drag.

Re claim 12, as shown in the provided evidence, the extent is “about” 25% or 30% as claimed.

Re claim 16, the illustrated width is considered to be “about” 40% as claimed. Furthermore, it would have been well within the level of skill of the ordinary routineer working in the art at the time of the invention to size the device as claimed. For example, when placing the device on boats of various widths, such sizing would provide results exactly as would be expected.

Claims 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view Stallman.

Applicant's disclosed Offer for Sale of the claimed invention, prior to the critical date of 11/6/2001 did not incorporate a flange extending about the extension inlet as claimed.

Stallman teaches a flange extending about an inlet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a flange to Applicant's disclosed device Offered for Sale as taught by Stallman.

Such a combination would have been desirable so as to prevent the entry of air into the inlet.

(10) Response to Argument

Appellant states on page 17, paragraph 3 in the brief that a declaration by the inventor, Mr. McDugle, “is attached herewith disclosing the various facts to the best of his recollection following the installation of the first rendition of the lateral thruster...”, and that “paragraph 3 establish that there is a nexus between the apparatus attached to Mr. Murch’s boat and the claims of the present application”.

In response, it is believed Appellant is referring the Declaration which was filed 3/20/2007, not the two copies of previously filed Declarations attached to the brief.

The Declaration of 3/20/2007 fails to show a nexus to the claimed invention, as the statement “to my knowledge of patent law, reads upon our pending claims” is ambiguous at best. It is unclear the level of knowledge of patent law possessed by the inventor, and therefore the statement made is unclear.

Appellant argues that such Declaration establishes that the inventor maintained control of the invention after sale, and therefore such is permitted experimental use.

In response, Appellant has not maintained adequate control of the invention. The Declaration filed 9/13/2004 states “Subsequent to that time (time of sale, when invention left control of Appellant), I made several follow-up

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inquiries to Mr. Murch and was not able to reach him. After about four to five months after his taking the boat, I was able to make telephone contact with Mr. Murch.” Such is not considered to be control of the experimental use. There is nothing of record to indicate Mr. Murch was informed of the experimental use, nor was he instructed to report back to the inventor of the performance of the invention, nor did Mr. Murch keep logs or records of the performance. When contact was finally made between the inventor and Mr. Murch, the items of discussion were a leaking boat, and faulty motor, not a discussion on such an experimental use and how the invention was performing.

Appellant argues that “post-installation improvements” were made responsive to the inventors contact with Mr. Murch.

The alleged “post-installation improvements” were the above mentioned leaking boat and motor. It should be noted that such were not improvements to the claimed invention, as such are not considered part of the invention. A faulty motor and/or faulty installation resulting in leaks are not considered related to the claimed invention.

Appellant argues that since the purchaser initiated the sale, and did not pay full price, and the inventor followed up with the purchaser, that such therefore constitutes acceptable experimental use.

The examiner does not agree, as even though an inventor followed up at some point in time, such is not an indication that the inventor maintained sufficient control over the experimental use. Attempting to establish communication with the purchaser is not communication itself, and therefore

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several months passed after the sale in which the inventor had no control, or communication with the purchaser at all. Attempting to contact the purchaser 5 to 7 times in a 5 month period is not considered a diligent attempt at maintaining control of the experiment.

Appellant states that the design of the invention was changed as result of the testing done by Mr. Murch. Such changes including the addition of a peripheral flange, and movement of the motor to a more lateral position as shown in figure 3 “(see the opener 104 to which a drive shaft is positioned in the ANSI text on page 20, beginning at line 6)” .

In response, reference to ANSI (American National Standards Institute) is unclear. If applicant is making reference to the application specification, the paragraph beginning on line 6 of page 20 indicates that the manner in which the thruster is mounted, including the opening 104 and drive shaft is conventional, and does not form part of the invention. Furthermore, it cannot be seen where the motor is even mentioned at all in the specification, nor shown in the drawings, and therefore such a motor forms no part of the invention. As far as the flange modification, it should be noted that such has not been claimed in claims 30-38, as the admitted sale more than one year before filing is a bar under 102(b) against these claims. If such a modification were considered essential to the invention, Appellant would not have filed claims to the initial prototype of the invention as originally sold to Mr. Murch. Claims 30-38 are evidence that the invention, at least in the eyes of the inventor, was “ready for patenting”, and therefore such fails the *Pfaff* two part test in this regard.

Appellant argues (re claims 30-38) that the changes made during experimentation need not be included in all of the claims.

In response, since claims 30-38 read upon the original device sold to Mr. Murch, such is evidence of reduction to practice and sale more than one year prior to filing, and therefore fails the two-prong *Pfaff* test. The other prong of the *Pfaff* is also considered to have been failed, as Appellant did not maintain control of the invention during testing, and did not inform the purchaser of his role in such testing. Therefore it is considered to have been a sale for other than experimental purposes. Experimental use ends upon a reduction to practice, and as noted above, claims 30-38 are evidence of an actual reduction to practice more than one year prior to filing. MPEP 2133.03(e)(5) indicates that the extent and supervision and control maintained by the inventor during an alleged period of experimentation, and the customers awareness of the experimentation is a significant determinative factor. Control and customer awareness ordinarily must be proven if experimentation is to be found. Note *Electromotive Div. Of Gen. Motors Corp.. v. Transportation Sys. Div. Of Gen. Elec. Co.*, 417 F.3d 1203, 1214, 75 USPQ2d 1650, 1658 (Fed. Cir. 2005). Also, once a period of experimental activity has ended and supervision and control is relinquished by the inventor without any restraints on subsequent use of an invention, an unrestricted subsequent use of the invention is a 35 U.S.C. 102(b) bar. *In re Blaisdell*, 242 F.2d 779, 784, 113 USPQ 289, 293 (CCPA 1957).

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Appellant argues that in a permissible experimental sale, that diligent follow up and monitoring is not required.

In response, note the argument set forth in the preceding paragraph.

Appellant's primary argument re the application of Den Ouden is that the modifying reference does not include the two extension members which are provided in the primary reference, Appellant's disclosed Offer for Sale.

Appellant argues that Den Ouden fails to show the width requirement of claim 12.

Again, it is the primary reference, Appellant's disclosed Offer for Sale which shows such a dimension. If the modifying reference had showed all these features, such would have been applied under 102(b).

Appellant argues re claim 39 that Stallman fails to show the thruster positioned clear of the water in high speed use.

In response, Stallman was not applied against claim 39.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ed Swinehart/

Conferees:

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Russell Stormer /RDS/

Samuel Morano /SJM/